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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,120	03/17/2004	Brian D. Cunningham	MESS-001/00US 307102-2003	5291
58249 7590 07/21/2009 COOLEY GODWARD KRONISH LLP ATTN: Patent Group Suite 1100 777 - 6th Street, NW WASHINGTON, DC 20001			EXAMINER JAKOVAC, RYAN J	
			ART UNIT 2445	PAPER NUMBER
			MAIL DATE 07/21/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/803,120	<b>Applicant(s)</b> CUNNINGHAM, BRIAN D.	
	<b>Examiner</b> RYAN J. JAKOVAC	<b>Art Unit</b> 2445	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 31-51, 53-79, 81-84 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/24/2009</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed 04/24/2009 has been entered.

### ***Examiner's Note***

2. The applicant's invention is directed towards a system that verifies the originator of an email. An information record relating to the message is stored by, for example, system A. The information record is stored in an information record database. The receiving email system, for example, system B, sends an email which includes the information record back to system A. System A compares the information record sent by system B to the information record stored in the information record database. System A sends an email to system B upon a successful comparison of the information records (Cunningham, [0062-0067].).

3. The Examiners cited prior art, Fabre, is a system to track email messages. Fabre, paragraph [0007]:

*Tracking of an e-mail communication refers to the creation of at least one record or metadata object that can be used to facilitate future reference to the contents of that communication from within the web-based business information system. Tracking methods can range from simple schemes generating flat-file listings on a per-end user,*

*per-recipient basis to more complex schemes involving message content analysis and indexing.*

The system as disclosed by Fabre comprises an e-mail tracking metadata database that stores the tracking information associated with the email communications (Fabre, [0043]). Fabre uses the stored tracking information and the tracking information included in the email messages to facilitate tracking and forwarding of successful responses (Fabre, [0058-0063].).

4. The Examiner's cited prior art, Tomkow, is a method verifying email transmission using for example digital signatures identifying the emails and reply verifications (Tomkow, pg. 4).

*In order to provide third party verification of the content and delivery of an electronic message such as an e-mail, a server 'tags' the message to indicate that it is 'registered' with the provider of the service. The server then transmits the tagged e-mail to the addressee's Mail User Agent MUA, as well as to the MUA's of any other addressees. After receiving responses from the receiving MUA's that the message was successfully received, the server then creates and forwards to the message originator an electronic receipt. The receipt includes one or more of the following: the original message; a delivery success/failure table listing which addressee's MUA's successfully received the message and at what time, and for which MUA's there was a delivery failure; and a digital signature corresponding to the message and attachments. (Tomkow, abstract.)*

5. The differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 31-51, 53-79, and 81-84 rejected under 35 U.S.C. 103(a) as being unpatentable over US 2005/0198158 to Fabre et al in view of WO 01/10090 to Tomkow.

Regarding claim 31-33, 36, 47-49, 52, 53, 76, the combination of Fabre and Tomkow teaches a method comprising:

associating with an electronic message authorized by an originator identification data uniquely identifying said electronic message (Tomkow, pg. 4, digital signature created and recorded for each message. See also abstract. See also, [0043] Fabre regarding the tracking information.);

storing said identification data (Fabre, [0043], e-mail tracking metadata database.);  
sending to an intended recipient said electronic message with said identification data (Fabre, [0050-0059], e-mail sent with tracking information.);

receiving on behalf of the intended recipient a confirmation request including said identification data and requesting confirmation that the said electronic message was authorized by the originator (Fabre, fig. 3a.);

comparing said identification data received in said confirmation request to said stored identification data (Fabre, fig. 3a, See also, [0050-0059], tracking string used to create forwarded version of reply email.); and

upon determining that said identification data received in said confirmation request matches said stored identification data, responding to said confirmation request, affirming said electronic message was authorized by the originator (Fabre, fig. 3a, See also, [0050-0059], tracking string used to create forwarded version (i.e. based on updated tracking string) of reply email.). See also pg. 4 of Tomkow.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Tomkow with the teachings of Fabre in order to facilitate the verification of email delivery and the tracking of email messages as well as to provide transparency to the system in regards to external email contacts (Fabre, [0009-0014].).

Regarding claim 34, 51, The combination of Fabre and Tomkow teaches the method of claim 31, wherein said identification data is included in a message header of said electronic message (Tomkow, pg. 30, 34. See also fig. 2F.).

Regarding claim 35, 46, 54, The combination of Fabre and Tomkow teaches the method of claim 31, wherein said sending includes attaching said identification data as an attachment to said electronic message (Tomkow, pg. 22-24, 33.).

Regarding claim 37, 50, 55, The combination of Fabre and Tomkow teaches the method of claim 31, further comprising: calculating a checksum for said message text; and including said checksum in said identification data and said second electronic message includes one of a text message, VoIP message, or instant message. (Tomkow, pg. 4-5, digital signature is created using a hash function on the message.).

Regarding claim 38-43, 56-61, The combination of Fabre and Tomkow teaches the method of claim 31, wherein said receiving a confirmation request includes receiving said confirmation request via port-to-port communication (Tomkow, pg. 4-5.).

Regarding claim 44, 45, The combination of Fabre and Tomkow teaches the method of claim 31, wherein said comparing is performed at a device different from a device at which said associating is performed, wherein said comparing is performed at a device different from a device at which said sending is performed (Tomkow, see at least pg., 4-5, 9, 36, 37, embodiments of Tomkow at originator, mail server, secondary mail server, website, and web based MUA. See also pg. 29.).

Regarding claim 62, The combination of Fabre and Tomkow teaches the method comprising: receiving a confirmation request to confirm that an electronic message sent to an intended recipient was authorized by an originator identified in the electronic message, the confirmation request including identification data purporting to uniquely identify the electronic message (Tomkow, pg. 26, copy of receipt is sent to verify information contained in the

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message.); searching a data store separate from said electronic message (Fabre, [0043.] for said identification data (Tomkow, pg. 26, message digests are searched.); and upon determining that said data store does not contain said identification data, responding to said confirmation request, denying the electronic message was authorized by the originator (Tomkow, pg. 33, data identifying the message as failed or undelivered is included in the delivery receipt.).

Regarding claim 63-68, 70-75, 77-79, 81-84, The combination of Fabre and Tomkow teaches the method of claim 62, wherein said receiving a confirmation request includes receiving said confirmation request via port-to-port communication, wherein said receiving a confirmation request includes receiving a confirming electronic message (Tomkow, pg. 4, receipt of delivery sent, reply is sent to verify and authenticate the information contained in the message (i.e. the message content, the digital signature, handshake and delivery history). See also 10-15, 22-24, and the abstract.).

Regarding claim 69, The combination of Fabre and Tomkow teaches the method comprising: receiving a confirmation request to confirm that an electronic message sent to an intended recipient was authorized by an originator identified in the electronic message, the confirmation request including identification data purporting to uniquely identify the electronic message; searching a data store for said identification data (Tomkow, pg. 4, receipt of delivery sent. See also 10-15, 22-24.); and upon determining that said data store contains said identification data, responding to said confirmation request, affirming the electronic message was authorized by the originator (Tomkow, pg. 4, reply is sent to verify and authenticate the



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information contained in the message (i.e. the message content, the digital signature, handshake and delivery history). See also abstract.).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN J. JAKOVAC whose telephone number is (571)270-5003. The examiner can normally be reached on Monday through Friday, 7:30 am to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on 571-272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/RJ/

/VIVEK SRIVASTAVA/

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